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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,998	04/02/2001	Richard Gilles	ESSR:039US	1742

7590 05/14/2003
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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,998

Applicant(s)

GILLES ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- ☐ Interview Summary (PTO-413) Paper No(s) _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

1. Claim 1 has been amended to introduce the limitation that a third comonomer, which has high Abbe number is a non-aromatic cyclic or polycyclic hydrocarbon. This amendment has overcome rejections under 35 USC 103(a) over EP'149 (Toh).
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
Claims 25-27 recite a "method of claim 8". However, claim 8 is drawn to a composition, and therefore, there are no steps as to the claimed method of the instant claims 22225-27.
4. Claims 1-12, 14-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al (U.S. 5,183,870).

The disclosure of Fukushima reads on the instant claims as follows:

Fukushima discloses a polymerizable composition comprising

(A) 10 to 60 parts by weight of a polybutylene glycol di(meth)acrylate represented by the general formula (I): (abstract)



(B) 20 to 80 parts by weight of a specific **urethane poly(meth)acrylate or epoxy poly(meth)acrylate**,

(C) 5 to 60 parts by weight of a specific mono(meth)acrylate, presented by the structures (II)-(V) in a paragraph bridging columns 2 and 3. and

(D) 0 to 60 parts by weight of a compound having at least one polymerizable double bond in the molecule, wherein the total amount of (A), (B), (C), and (D) being 100 parts by weight. (abstract).

The compound (B) constituting the second component is used to improve the thermal resistance of the resulting lenses, because lenses formed by using only the polybutylene di(meth)acrylate (A) constituting the first component will fail to have satisfactory thermal resistance (column 4, lines 12-17).

Useful urethane poly(meth)acrylates having two or more (meth)acryloyloxy groups in the molecule, which can be used as the compound (B), include products obtained by the urethane-forming reaction of a (meth)acrylate containing a hydroxyl group with a polyisocyanate having two or more isocyanate groups in the molecule (col. 4, lines 18-25). Suitable methacrylates and isocyanates are presented in col. 4, lines 26-55. These monomers are readable on the monomers (II) of the instant claims. With regard to component (C) of Fukushima, the specific examples of these compounds are presented in columns 7, 8 and 9 up to line 50. Examples of component (D) are presented in col. 11, lines 27-33, and are cyclic or polycyclic aromatic compounds having Methacrylate

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functionality. The refractive index of Fukushima's polymers is presented in Table 1, col. 14, and is within the claimed range.

The disclosure of Fukushima differs from the instant claims by disclosing butyleneoxy group versus propyleneoxy group, as moiety A in claim 1. However, propylene and butylenes radicals are closest homologs (compounds that differ by only one $-CH_2$ group). However, structural similarities have been found to support a prima facie case of obviousness. See, e.g.; *In re Wilder*, 563 F.2d 457, 460, 195 USPQ 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); Generally, some teaching of a structural similarity will be necessary to suggest selection of the claimed species or subgenus. Therefore, lacking showing criticality of having propyleneoxy group, as moiety A, on this record, a person skilled in the art would have reasonably expected functional similarities between the products of Fukushima and instant polymers based on the structural similarities, as discussed above.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/061,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are read as species on the generic claims (broader) of U.S. Application NO. 10/061,761.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703)308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-24-50. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Tatyana Zafukaeva
Primary Examiner
Art Unit 1713

May 12, 2003